

## REMARKS

In the application claims 1, 2, and 5-19 remain pending. Claims 3 and 4 have been canceled as being drawn to a non-elected species of the invention.

The claims have been amended only to comply with the requirements of form set forth in the Office Action. Accordingly, it is requested that the objection to the claims be withdrawn.

In the Office Action, claims 1-2 and 5-19 were rejected under 35 U.S.C. § 103 as being rendered obvious over Tessier (U.S. Patent No. 5,629,868) in view of Beery (U.S. Patent No. 5,963,269) *in further view of "official notice."* The reconsideration of this rejection of the claims is respectfully requested.

It is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that the combination of references being relied upon disclose the claimed invention “as a whole.” The requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, *with no knowledge of the claimed invention*, would have selected the various parts from the references and combined them in the claimed manner.

Considering first the use of “official notice” in the rejection of the claims, it is respectfully requested that an authority be produced that can be said to support the alleged obviousness of modifying either Tessier or Berry to arrive at the entirety of the invention claimed. In this regard, while it might be “well known” to display on a video screen for reading by a human a channel number currently being viewed, it is respectfully traversed that it would be “well known” to cause a video screen to *flash* to specify a channel number currently being viewed, let alone for providing a channel number currently being viewed *to a remote control* as is set forth in the claims at issue. More particularly, it is respectfully traversed that one of ordinary skill in the art at the time of the invention, having no knowledge of the invention claimed, would have been led to use the mere knowledge that a channel number currently being viewed may be displayed on a video screen to a human to thereby modify either Tessier or Berry to *flash* a video screen in a manner that functions to specify to a remote control a channel number currently being viewed as is set forth in the claims at issue. Thus, to ensure a compete record in the event that it is required to take the subject application to Appeal, it is submitted that concrete evidence in support of the “official notice” must be placed into the record of the subject application. *See* MPEP § 2144.03.

It is additionally respectfully submitted that, by this reliance upon “common knowledge,” the Office Action has acknowledged that neither Tessier nor Berry discloses, teaches, or suggests the desirability of using flashes of a video screen to convey to a remote control a channel currently being viewed whereupon the remote control may use the information conveyed by the video screen flashes to update a favorite channels list maintained within the remote control.

That Tessier fails to disclose, teach, or suggest using flashes of a video screen to convey to a remote control a channel currently being viewed whereupon the remote control may use the information conveyed by the video screen flashes to update a favorite channels list maintained within the remote control has been acknowledged in the Office Action.

Considering now Beery, while Beery may disclose a remote control having a favorite channels list, it is respectfully noted that Beery expressly discloses that the channels are assigned to the favorite channels list by a user manually programming the remote control with the channel numbers that are to be included within the favorite channels list. (Fig. 7, steps 378+). Nowhere, however, does Beery disclose, teach, or suggest the desirability of using information generated by another appliance, let alone a video screen, to populate a favorite channels list maintained within a remote control. Accordingly, it is not evident nor has it been explained why the mere disclosure within Beery of a programmable favorite channels list would lead one of skill in the art at the time of the invention, with no knowledge of the claimed invention, to modify Tessier to arrive at a system that would even generally use information provided from another appliance to populate a favorites channel list, let alone to arrive at a system that includes all of the elements specifically set forth within the claims. Rather, “to allow quick access to pre-selected favorite channels or programs” within the system of Tessier, which is the espoused motivation for modifying Tessier, Beery suggests nothing more than modifying the remote control of Tessier such that the remote control includes a program that allows a user to interact with the keys of the remote control to manually create and maintain a favorite channels list within the remote control. It will be appreciated that this is in direct

contrast to that which is claimed. Accordingly, since the rejection of the claims fails to provide the required rational explanation as to why and how one of ordinary skill in the art at the time the invention would have used the teachings of Beery to modify the system of Tessier to arrive at a system in which a favorite channels list is even generally populated using information generated by another appliance, it is submitted that the rejection of the claims under 35 U.S.C. § 103 must be withdrawn. *See MPEP § 706.02(j)* and In re Lee, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002).

In sum, since no reference has been cited which can be said to disclose, teach, or suggest at least the desirability of using information generated by another appliance to populate a favorite channels list maintained by a remote control, let alone information in the form of video screen flashes representative of a channel currently being viewed, it is respectfully submitted that the rejection of the claims fails to present a *prima facie* case of obviousness in accordance with the requirements of 35 U.S.C. § 103 and, as such, the rejection under 35 U.S.C. § 103 must be withdrawn.

Should it be determined that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fees are due, the Commissioner is authorized to charge any fee deficiency to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

By:

Gary R. Jarosik, Reg. No. 35,906  
Greenberg Traurig, LLP  
77 W. Wacker Drive, Suite 2500  
Chicago, Illinois 60601  
(312) 456-8449

Date: June 12, 2006